

Application No.: 10/772.752
Amendment dated: July 8, 2011
Reply to Office Action of February 8, 2011
Attorney Docket No.: 22176.28 (ITW-14460)

REMARKS/ARGUMENTS

Claims 1 and 3-16 are pending in this application.

Claims 7-10 and 12-14 had been withdrawn.

Claims 1, 3, 5, 11, 15, and 16 have been amended as indicated hereinabove.

Claim 2 has been canceled without prejudice or disclaimer.

Claims 5 and 16 had been rejected under 35 U.S.C. § 112, first paragraph.

Applicant believes that the Claims as amended are now in compliance with 35 U.S.C. § 112, first paragraph.

Claims 1, 3, 6, 11, and 15 had been rejected under 35 U.S.C. § 103(a) over Rice (U.S. Patent No. 5,396,839). This rejection is respectfully traversed for the following reasons.

If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent.¹ The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of non-obviousness.²

The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."³ "[T]o determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue . . . this analysis should be made explicit. . . . [A] patent composed of several elements is not proved obvious merely by demonstrating that

¹ *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)

² *Manual of Patent Examining Procedure* § 2142 (8th ed. rev. 7 July 2008)

³ *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International Co. v. Teleflex Inc.* [hereinafter *KSR*], 550 U.S. 398, 418, 82 USPQ2d 1385, 1396 (quoting Federal Circuit statement with approval)

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each of its elements was, independently, known in the prior art. . . . [I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does."⁴

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.⁵ A prima facie case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention.⁶ Evidence showing there was no reasonable expectation of success may support a conclusion of non-obviousness.⁷

Claims 1, 3, 6, 11, and 15, as amended, comprise multiple separate portions of each panel being selectively transferrable onto the substrate to become parts of an image on the substrate.

This element is described in the specification, as published, paragraphs [0022], [0024], [0026]-[0027], and [0031]-[0033].

Multiple separate portions of each panel being selectively transferrable onto the substrate to become parts of an image on the substrate are not disclosed, taught or suggested in Rice.

In Rice, contrary to Claims 1, 3, 6, 11, and 15, as amended, the purpose of the disclosed system is to form a composite image 48 consisting of a pattern 49, not to transfer parts of the image 48 to a substrate while keeping other parts of the image 48 off the substrate.

Therefore, Claims 1, 3, 6, 11, and 15, as amended, are patentable and non-obvious Rice under 35 U.S.C. § 103(a) and should be allowed.

⁴ KSR, 550 U.S. at 418, 82 USPQ2d at 1396

⁵ *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

⁶ *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997)

⁷ *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976)

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Claim 4 had been rejected under 35 U.S.C. § 103(a) over Rice in view of Mallik et al. (U.S. Patent No. 5,085,514). Claims 5 and 16 had been rejected under 35 U.S.C. § 103(a) over Rice in view of Moon et al. (U.S. Patent No. 7,126,755). These rejections are respectfully traversed for the following reasons.

If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious.⁸

Claims 4-5 and 16 depend on independent Claims 1 and 11, which, as explained above, are non-obvious. Therefore, Claims 4-5 and 16 are patentable over Rice, Mallik, and Moon under 35 U.S.C. § 103(a) and should be allowed.

It is believed that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited in this case. Should any questions arise, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

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⁸ *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).